

### **REMARKS**

In the office action, claims 1-31 were rejected. By the present response, claims 1, 4, 14, 24, 27, and 28 are amended. Upon entry of the amendments, claims 1-5, 7-24, 26-29, and 31 will remain pending in the present patent application. Reconsideration and allowance of all pending claims are requested.

### **Premature Finality of the Office Action and Interview Summary**

On a preliminary note, the applicants respectfully note that the previous office action mailed on June 9, 2009 failed to address the status of claims 3, 7-13, 15-17, 20-23, 26, 29, and 31. The applicants were, therefore, deprived of any opportunity to meaningfully respond or advance the prosecution of claims 3, 7-13, 15-17, 20-23, 26, 29, and 31 in the previous response to the office action mailed on June 9, 2009. Accordingly, the applicants respectfully request that the examiner issue a communication clarifying the status of claims 3, 7-13, 15-17, 20-23, 26, 29, and 31. The applicants further emphasize that such a communication, if issued as an office action, should not be final in view of the incomplete nature of the office action.

In order to further clarify the issues, a telephonic interview took place on May 7, 2010 with the examiner's supervisor, Mr. Gerald J. O'Connor. In accordance with 37 C.F.R. §1.133 and M.P.E.P. §713.04, the applicants hereby provide the following summary of a telephonic interview between supervisor O'Connor, and the applicants' attorneys, Patrick S. Yoder and Ricardo Yopez. The applicants' attorneys explained to supervisor O'Connor that the previous office action mailed on June 9, 2009 failed to address a number of the present claims. Supervisor O'Connor agreed with the applicants' attorneys that should the previous office action indeed fail to address such claims, then the finality of the current office action would be erroneous. Supervisor O'Connor helpfully suggested that a telephonic call be placed after submission of the present response to follow up on the removal of the finality of the present office action. The

applicants' attorneys would like to thank supervisor O'Connor for his time and advice and will follow up with a telephonic call after submission of the present response.

In view of the aforementioned passages and the telephonic interview, among others, the applicants stress that the present final office action is premature regarding the pending claims, particularly claims 3, 7-13, 15-17, 20-23, 26, 29, and 31. Consequently, the applicants respectfully request that the examiner remove the finality of the present office action.

#### **Rejections Under 35 U.S.C. §101**

With respect to the examiner's rejection of claims 1, 4, 14 and 24 under §101 as being directed to non-statutory subject matter, the examiner stated that the "claims state 'machine readable medium' implying the same use as a computer readable medium as having functioning hardware to perform the steps of the claim. Further implying that the limitations are executable by programmable computer workstations to reside." *See* Office Action, pg. 2. The applicants respectfully traverse this rejection.

#### ***Legal Precedent and Guidelines***

In the case of *In re Bilski*, the Federal Circuit explored the origins of several legal standards previously adopted by the courts in assessing the patentability of methods or processes under 35 U.S.C. § 101. *In re Bilski*, 88 U.S.P.Q.2d 1385 (Fed Cir. 2008) (*en banc*). In its decision, the Federal Circuit set forth that the proper standard for assessing the patentability of *process or method* claims under Section 101 is to determine whether the claimed process is "tied to a particular machine" or if the claimed process "transforms an article." *Id.* at 1396 (citing *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972)). In view of this holding, the Federal Circuit also reiterated the guidelines for properly applying the "machine-or-transformation" test in evaluating the patentability of process or method claims, stating specifically:

The machine-or-transformation test is a *two-branched* inquiry; an applicant may show that a process claim satisfied § 101 either by showing that his claim is tied to a particular machine, or by showing that his claim transforms an article. *See Benson*, 409 U.S. at 70. Certain considerations are applicable to analysis under either branch. First, as illustrated by *Benson* and discussed below, the use of a specific machine or transformation of an article must impose meaningful limits on the claim's scope to impart patent-eligibility. *See Benson*, 409, U.S. at 71-72. Second, the involvement of the machine or transformation in the claimed process must not merely be insignificant extra-solution activity. *See Flook*, 437 U.S. at 590.

*Id.* (emphasis added).

In other words, the *Bilski* court has made it clear that if a claim directed to a *method or a process* is either tied to a machine or device, or performs a transformation of an article into a different state or thing, then the claimed *method or process* qualifies as statutory subject matter under 35 U.S.C. §101.

#### ***Deficiencies of the Rejections of Independent Claims 1, 4, 14, and 24***

While the applicants do not necessarily agree with the §101 rejections set forth by the examiner, to further prosecution, the applicants have amended independent claims 1, 4, 14, and 24. At least in view of these amendments, the applicants respectfully assert that independent claims 1, 4, 14, and 24, as well as claims depending therefrom, are directed to statutory subject matter under §101, as they are directed to the transformation of an article (e.g., anatomical features or functions) to a different state or thing (e.g., a multi-media patient summary). In particular, independent claim 1 recites a multi-media patient summary ... comprising information including data representative of an anatomical feature or function stored on one or more formats and generated by ... accessing of patient information ... entering the patient information into a digital file ...

storing the digital file onto a machine readable medium ... and loading the digital file at file at one or more remote client workstations.” Emphasis added. Amended independent claim 4 is directed to a method for providing a multi-media patient summary, the method comprising “accessing patient information including data representative of an anatomical feature or function ... assembling the patient information into a digital file... storing the digital file... onto a machine readable medium; and accessing the digital file at one or more client workstations coupled to the compilation workstation via a network.” Emphasis added. Similarly, amended independent claims 14 and 24 contain the same recitation of “patient information including data representative of an anatomical feature or function” and generally similar recitations of receiving the patient information, storing the information, generating or creating a multi-media patient summary, and utilizing client workstations.

The applicants respectfully submit that the recited multi-media patient summary clearly qualifies as a transformation of the data representative of an anatomical feature or function. Indeed, the data representative of an anatomical feature or function is transformed into a multi-media patient summary. Further, the applicants assert that the transformation constitutes more than an insignificant extra-solution activity. *See Benson*, 409 U.S. at 71-72 (quoting *Flook*, 437 U.S. at 590). Additionally, the recitations of independent claims 1, 4, 14, and 24 include the use of a client workstation, which ties the independent claims to a machine (e.g., the client workstation). Thus, because amended independent claims 1, 4, 14, and 24 clearly recite the transformation of an article as well as the tie-ins with a particular machine, the applicants respectfully submit that the §101 rejection of independent claims 1, 4, 14, and 24, as well as all claims depending therefrom, is obviated. As such, the applicants respectfully request withdrawal of the rejection of claims 1, 4, 14, and 24 under 35 U.S.C. §101.

### **Rejections Under 35 U.S.C. §103**

In the office action, the examiner rejected claims 1, 2, 4, 5, 11, 14, 15, 19, 24, 28 and 31 under 35 U.S.C. §103(a) as being unpatentable over Killcommons, U.S. Patent No. 7,606,861 (hereinafter referred to as “Killcommons”) in view of Menschik, U.S. Publication No. 2004/0034550 (hereinafter referred to as “Menschik”). Claims 3, 7-10, 12, 13, 16, 17, 20, 21, 22, 26, and 29 were rejected under 35 U.S.C. §103(a) as being unpatentable over Killcommons in view of Menschik in further view of Teshima, U.S. Patent No. 6,272,470 (hereinafter referred to as “Teshima”). Claims 18, and 27 were rejected under 35 U.S.C. §103(a) as being unpatentable over Killcommons in view of Menschik in further view of Campbell, U.S. Patent No. 6,047,259 (hereinafter referred to as “Campbell”). The applicants respectfully traverse these rejections.

### ***Legal Precedent and Guidelines***

The burden of establishing a *prima facie* case of obviousness falls on the examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (B.P.A.I. 1979). To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 180 U.S.P.Q. 580 (C.C.P.A. 1974). However, a claimed invention composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. *KSR International Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741 (2007). The *KSR* court stated that “it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does ... because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known.” *Id.* Specifically, there must be some articulated reasoning with a rational underpinning to support a conclusion of obviousness; a conclusory statement will not suffice. *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006). Indeed, the factual inquiry determining whether to combine references

must be thorough and searching, and it must be based on objective evidence of record. *In re Lee*, 61 U.S.P.Q.2d 1430, 1436 (Fed. Cir. 2002).

Furthermore, there must be some reason to combine references other than the hindsight gained from the invention itself, i.e., something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination. *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044 (Fed. Cir. 1988). One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). The Federal Circuit has warned that the examiner must not, “fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.” *In re Dembiczak*, F.3d 994, 999 (Fed. Cir. 1999) (quoting *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553 (Fed. Cir. 1983)).

In addition, it is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 U.S.P.Q. 769, 779 (Fed. Cir. 1983); M.P.E.P. §2145. Moreover, if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 U.S.P.Q. 349 (CCPA 1959); *see* M.P.E.P. §2143.01(VI). Further, if the proposed modification or combination would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984); *see* M.P.E.P. §2143.01(V).

***Deficiencies of the Rejections of Independent Claims 1, 4, 14, 24, 27 and 28***

Independent claims 1, 4, 14, 24, 27, and 28, as amended, recite “entering the patient information into the digital file by utilizing an electronic template.” Emphasis added. Moreover, claim 4 recites “assembling the patient information into a digital file by utilizing an electronic template;” claim 14 recites “receiving patient information including data representative of an anatomical feature or function stored on one or more formats from one or more systems by utilizing an electronic template;” claim 24 recites “at least one compilation workstation configured to assemble the patient information into a digital file by utilizing an electronic template;” claim 27 recites “means for assembling the patient information into an electronic file capable of encapsulating patient information having different formats by utilizing an electronic template;” and claim 28 recites “a routine for assembling and encapsulating the patient information into a digital file by utilizing an electronic template.”

Neither Killcommons, Menschik, or Campbell teach or suggest utilizing an electronic template, as recited, *inter alia*, by the independent claims 1, 4, 14, 24, 27, and 28. Indeed, the phrase “electronic template” or any analogous term or teaching is completely missing from Killcommons, Menschik, and Campbell. By way of contrast, Killcommons teaches *the use of emails* to assemble and submit information to user locations. See Killcommons, col. 4, lines 1-13 and FIGS. 2A-2D. Menschik teaches “*the direct transfer* of medical data between ‘peers’.” Menschik, paragraph 19(emphasis added). Campbell teaches the *direct data entry* of patient data into a computer system. See Campbell, col. 6, lines 47-55. Accordingly, neither Killcommons, Menschik, or Campbell teach or suggest “utilizing an electronic template,” as recited by the independent claims. No combination, then, could teach all elements of the claimed invention.

Further, it is improper to combine references where the references teach away from their combination. *See In re Grasselli*, 713 F.2d 731; *see also* M.P.E.P. §2145. Indeed, the Killcommons and Menschick references proffered by the examiner teach away from their combination. More specifically, Killcommons teaches away from the combination with Menschick because Killcommons *requires the use of standard emails* to assemble and submit information to other systems. *See* Killcommons, col. 4, lines 1-13 and FIGS. 2A-2D. This is in direct contradiction with Menschick, which teaches that the assembly and submittal of information between systems should be “secure, centrally-mediated, peer-to-peer.” Menschick, paragraph 27. As a person of ordinary skill in the art can appreciate, email-based systems are notoriously insecure, decentralized, and not peer-to-peer. The two references attempt to solve the problem using two completely opposite approaches. One approach teaches centralization and security, while the other approach teaches decentralization and open email communication. Clearly, Killcommons and Menschick teach away from the combination with each other.

For at least these reasons, among others, the applicants submit that the combination of Killcommons, Menschick, and Campbell cannot support a *prima facie* case of obviousness, and should be withdrawn. The applicants respectfully request withdrawal of the rejections under 35 U.S.C. §103 and allowance of claims 1, 4, 14, 24, 27, and 28 as well as those claims depending therefrom.

***Deficiencies of the Rejections of Dependent Claims 3, 7-10, 12, 13, 16, 17, 20-22, 26, and 29 as being unpatentable over Killcommons in view of Menschick further in view of Teshima***

The dependent claims incorporate the recitations of independent claims 1, 4, 14, 24, 27, and 28. As noted above, Killcommons and Menschick do not teach or suggest all of the recitations of independent claims 1, 4, 14, 24, 27, and 28. For example, the Killcommons and Menschick do not teach or “entering the patient



information into the digital file by utilizing an electronic template,” as recited by independent claims 1, 4, 14, 24, 27, and 28. Any combination with Teshima does not appear to correct the deficiencies of Killcommons and Menschik. Furthermore, Killcommons and Menschik teach away from their combination. Therefore, the applicants respectfully assert that the rejection of dependent claims 3, 7-10, 12, 13, 16, 17, 20-22, 26, and 29 under 35 U.S.C. §103(a) should be withdrawn.

### **Conclusion**

In view of the remarks and amendments set forth above, the applicants respectfully request allowance of the pending claims. If the examiner believes that a telephonic interview will help speed this application toward issuance, the examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

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